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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,881	09/11/2003	Yoel Wazana	21101-0006	5001

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EXAMINER

ELVE, MARIA ALEXANDRA

ART UNIT	PAPER NUMBER
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1725

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/659,881

Applicant(s)

WAZANA ET AL.

Examiner

M. Alexandra Elve

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6 & 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Araki (USPN 6,223,010) in view of Basista et al. (USPN 6,609,044) and Piccioli et al. (USPN 4,549,066).

Araki discloses a resin product with the method and apparatus used for disassemble. The cartridge is cut with a laser.

Araki does not teach the use of a computer or a gimbal (that rotation of the part).

Basista et al. discloses the use of a computer and an associated program for laser cutting.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a computer and cutting program as taught by Basista et al. in the Araki system because it would ensure cutting accuracy and decrease processing time.

The provision of mechanical or automated means to replace a manual activity was held to have been obvious. In re Venner 120 USPQ 192.

Piccioli et al. discloses the cutting of a molded polyester resin product using a laser. The polyester resin product is rotated while the laser cuts the excess product off.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a rotation device, as taught by Piccioli et al. in the Araki system because of the enhanced ease of product handling during the disassembly process.

Claims 7 & 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Araki in view of Koike et al. (USPN 6,864,294).

Araki discloses a resin product with the method and apparatus used for disassemble. The cartridge is cut with a laser.

Araki does not teach the type of resin material used.

Koike et al. discloses the recycling of a resin product. The prime example is a thermoplastic ink jet cartridge. The recycled material is typically a thermoplastic ABS resin (acrylonitrile butadiene styrene resin), which is a so-called styrene based polymer.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use ABS, as taught by Koike et al. in the Araki system because this is merely a type of resinous material that is traditionally used in cartridges.

The prior art discloses a product substantially similar to a claimed product, differing only in the manner by which it is produced. It has been held that one of ordinary skill in the art at the time of the invention would have considered the claimed product because of the similarities in appearance, properties and function. The burden falls to the applicant to show that any process steps associated with the claimed product results in a materially different product from those of the prior art, because there is nothing in the record before the examiner to reasonably conclude that applicant's

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product differs in kind from those obtained by the references. See *In re Brown* 173 USPQ 685 and *In re Fessman* 180 USPQ 324.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Araki and Basista et al. and Piccioli et al., as stated above and further in view of Koike et al.

Araki and Piccioli et al. disclose a cartridge but not the type of material used.

Koike et al. discloses the recycling of a resin product. The prime example is a thermoplastic ink jet cartridge. The recycled material is typically a thermoplastic ABS resin (acrylonitrile butadiene styrene resin), which is a so-called styrene based polymer.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use ABS, as taught by Koike et al. in the Araki and Piccioli et al. system because this is merely a type of material that is traditionally used in cartridges.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Araki and Koike et al., as stated above and further in view of Baley (USPN 5,676,794).

Araki and Koike et al. do not teach the cutting route.

Baley discloses the cutting of a toner cartridge for remanufacturing. The figures show that the disassembly is around the rectangular plate that is essentially a circuitous route.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a circuitous route, as taught by Baley in the Araki and Koike et al.

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system because this is merely tracing the usually path which is used to disassemble the toner cartridges.

Response to Arguments

Applicant's arguments filed 5/12/06 have been fully considered but they are not persuasive.

Applicant argues that the prior art does not teach an apparatus for disassembling containers having interfacing thermoplastic joining surfaces. In response to applicant's arguments, the recitation "an apparatus for disassembling containers having interfacing thermoplastic joining surfaces" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant argues that Basista et al. does not teach "cutting containers having interfacing thermoplastic joining surfaces". In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that the prior art does not teach an apparatus for disassembling containers having interfacing thermoplastic joining surfaces. In response to applicant's arguments, the recitation "an apparatus for disassembling containers having interfacing thermoplastic joining surfaces" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant argues that Koike et al. does not teach "cutting containers having interfacing thermoplastic joining surfaces". In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that the prior art does not teach an apparatus for disassembling containers having interfacing thermoplastic joining surfaces. In response to applicant's

arguments, the recitation “an apparatus for disassembling containers having interfacing thermoplastic joining surfaces” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant argues that Piccioli et al. does not teach “cutting containers having interfacing thermoplastic joining surfaces”. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Alexandra Elve whose telephone number is 571-272-1173. The examiner can normally be reached on 6:30-3:00 Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 5, 2006.



M. Alexandra Elve
Primary Examiner 1725